

REMARKS

Summary of the Office Action

Claims 10, 14-19, and 28-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,794,833 to *Strååt*.

Claims 20-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Strååt*, in view of U.S. Patent No. 7,048,165 to *Haramiishi*.

Summary of the Response to the Office Action

Applicants amend claim 10. Accordingly, claims 10, 14-21, and 28-30 are presently pending.

The Rejections Under 35 U.S.C. § 102(b)

Claims 10, 14-19, and 28-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,794,833 to *Strååt*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Strååt* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Applicants respectfully submit that the newly amended independent claim 10 recites "a pull-out opening through which the roll staple is pulled out, wherein the pull-out opening is provided at the midpoint of a front face of the staple case," and these features are not disclosed in *Strååt*. *Strååt* does not provide at least a pull-out opening located at the midpoint of a front face of the staple case. *Strååt* shows the pull-out opening to be located near a corner of the roll staple case (10a, 10b). See Fig. 3 of *Strååt*. Contrary to the

Office Action, the location of the pull-out opening's relative position is easily understood by both a layman and one of ordinary skill in the art. *Strååt* fails to teach or suggest at least these features of claim 10.

As pointed out in M.P.E.P § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Strååt* does not teach or suggest each feature of newly amended independent claim 10.

Additionally, Applicants respectfully submit that dependent claims 14-19 and 28-30 are also allowable insofar as they recite the patentable combinations of features recited in claim 10, as well as reciting additional features that further distinguish over the applied prior art.

The Rejections Under 35 U.S.C. § 103(a)

Claims 20-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Strååt*, in view of *Haramiishi*. Applicants respectfully traverse the rejection for at least the following reasons.

The Office Action has not established a *prima facie* case of obviousness at least because *Strååt* and *Haramiishi*, whether alone or in combination, fail to teach or suggest all the recited features of independent claim 10. Newly amended independent claim 10 recites, in part, "a pull-out opening through which the roll staple is pulled out, wherein the pull-out opening is provided at the midpoint of a front face of the staple case." *Strååt* or *Haramiishi*, whether taken alone or in combination, fail to teach or suggest at least these features of claim 10.

As previously demonstrated, *Strååt* fails to teach or suggest each and every feature of claim 10. *Haramiishi* does not cure this deficiency in *Strååt*. *Haramiishi* is only relied upon only to show a direction arrow located on the staple case. Thus, the rejection of claims 20-21 should be withdrawn.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Strååt* or *Haramiishi*, whether taken alone or in combination, fails to teach or suggest fail to teach or suggest each feature of newly amended independent claim 10, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, claims 20-21 depend from independent claim 10. Accordingly, claims 20-21 are also allowable because of the additional features they recite and the reasons stated above.

Conclusion

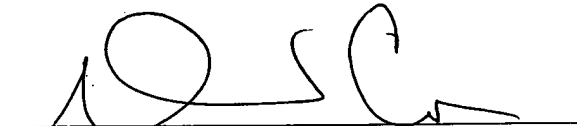
In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of all pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By:


David E. Connor
Reg. No. 59,868

Dated: August 22, 2008

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202-739-3000
Fax: 202-739-3001